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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D., 1926

No. 325

TEMCO ELECTRIC MOTOR CO.,
Petitioner,

vs.

APCO MANUFACTURING CO.,
Respondent.

BRIEF FOR RESPONDENT

GENERAL STATEMENT

The Record.

The record in this case is materially different from the record in the K-W case in the Sixth Circuit. The K-W record did not contain certain prior art, the judgments and records in interference proceedings before the Patent Office and the Court of Appeals of the District of Columbia between petitioner's patentees Thompson & Thompson and respondent's patentee Storrie, and other material evidence.

The record at page 285 and petitioner's brief at page 36 contains illustrative charts the correctness of which we challenge in that they contain statements purporting to be

expressions of the Court of Appeals of Sixth Circuit, whereas no such statements were ever made by that Court and certain of such illustrations and structures were not before that Court.

The transcript of the record for some unexplained reason does not contain the patent in suit but we have in this brief described the plaintiff's devices and set forth the claims as well as claims which the patentees cancelled during prosecution of the application, together with illustrations of the prior art and a chart used by petitioners in the K W case.

Prior Suits in Sixth Circuit.

The K-W case.

Plaintiff's counsel set out in the index and otherwise in their brief a number of suits brought by plaintiff against others in the Sixth Circuit. The only case in which a real contest was had is the case against the K W Company. Even in that case the defendant was a former sales agent for the plaintiff; had in the agency agreement admitted the validity of the Thompson patent and had engaged in gross unfair competition. Mr. Justice Clarke sustained the patent with "misgiving" (page 348 of the K-W Record), and said that

> "Defendant avowedly started out not to patent an invention but to invent a patent, and as is usual in such cases the result is an infringement and not a discovery. To this it should be added that a device avowedly worked up to evade a patented article to which the persons claiming under it sustained the relation which the defendant sustained in this case to the device of the plaintiff, should not be weighed in golden scales for the purpose of discovering merits to save it from being considered an infringing construction."

In that case the equities were such that on the final accounting (283 Fed. Rep. p. 873), the Court of Appeals of

the Sixth Circuit decided that a penalty of $50,000 for punitive damages "is not a sufficient award for these purposes. We think it should be increased to $100,000."

Mr. Justice Clark had before him an incomplete or limited showing of the prior art but even with that limited art he was evidently undecided as to whether the Thompson patent on its very narrow claims involved the slightest amount of invention. His final conclusion was that "Upon the whole, though not without misgiving," the patent was valid.

The Circuit Court of Appeals of the Sixth Circuit decided specifically that "It is a narrow patent, but it involves invention and is valid."

As we shall hereinafter show the infringing K-W shock absorber was the specific device of the claims of the patent in suit. Neither the District Court nor the Court of Appeals of the Sixth Circuit specially analyzed the claims.

Forest City case.

This case never went to the Court of Appeals. The financial embarrassment of the company and its eventual bankruptcy hampered a proper defense of that case. There was a stipulation between the original counsel for the Forest City Company and counsel for plaintiff that the trial of the case should await the decision of the Court of Appeals in the K-W case. When the suit did come on for trial it was defended largely, if not wholly, on the issue of prior use of a "J. M." shock absorber.

Halladay case.

Halladay never defended that suit. The suit was brought against Halladay and one of his dealers, Brown, in Toledo, and Halladay elected not to defend the suit. He afterwards adjusted the matter with the Temco Company. The decree against Brown, his dealer, was there-

fore largely a default decree. No appeal was taken in this case by Brown or Halladay.

The Pennsylvania Rubber Co. case.

The injunction issued in this case is erroneously or incorrectly entitled as against the Apco Company (Record, page 270). This case was never contested and an examination of the formal record which plaintiff's counsel made in that court (page 316 of record) shows that in view of the fact that Pennsylvania Rubber Company did not defend the case, Judge Westenhaver specifically stated that the **decree to be entered should have carried into it the showing "that the defendant does not appear at this hearing either in person or by counsel."** Plaintiff's counsel came into Court with the decree already prepared (page 329 of the record).

Cooper Rubber Company case.

This is another suit brought against a dealer. No defense was made and a decree taken by default. We are advised the Cooper Rubber Company sold about twenty five (25) sets of Apco absorbers.

Belknap Hardware Company case.

This suit was also uncontested and a decree therein was entered by default. The Belknap Company, we understand, settled for approximately $200.

Tennessee Mill and Supply Company case.

This was also a default or consent decree, that Company selling between twenty five to fifty sets of absorbers.

Conflict of Decisions.

The findings of the Courts of the Fifth and Sixth Circuits are in agreement in respect of the narrowness of the

Thompson patent on its face and with relation to the prior art. The Courts of the Sixth Circuit did not specifically analyze or deal with the claims of the patent in suit, but in holding the patent valid, the Circuit Court of Appeals did not except Claim 3 and we assume that because of the apparent conflict of the decisions of the two Courts of the Fifth and Sixth Circuits, because of the finding of the Court of Appeals of the Fifth Circuit that Claim 3 is incomplete and invalid, this Honorable Court issued its writ of certiorari. On the question of infringement hereinafter discussed, there is no conflict between the Courts of Appeals of the Fifth and Sixth Circuits. Not only did the Court of Appeals of the Sixth Circuit exclude the radius link absorber as being an infringement of the Thompson patent but the petitioner **contended before that Court and before the Patent Office**, where it was seeking a patent on the radius link absorber before it knew of the application of Mr. Storrie for the radius link absorber, that such an absorber **was not an infringement of the patent in suit.** As we shall show it was only after petitioner in the interference proceedings had failed to obtain a patent and had failed to obtain a license under the Storrie patent (Respondent's licensee) that it conceived of the plan of changing its heretofore clearly expressed position on the Thompson patent and eight years after its patent had been sustained in the Sixth Circuit, bringing suit against respondent for infringement, and then only because it had surreptitiously copied the respondent's device under an assumed name of "Edward Bros." and sought by this suit to lend some color of right to its unjust conduct.

THE PATENT IN SUIT.

The patent drawings show, and the specification describes a shock absorber comprising essentially a coiled spring mounted for compression by movement of the leaf spring, the axle and body of the automobile, to absorb

such vibrations and shocks as ordinarily without the relatively sensitive coiled spring would be transmitted from the leaf spring to the body. Referring to the drawing of patent in suit (Plaintiff's Ex. 7, not in record):

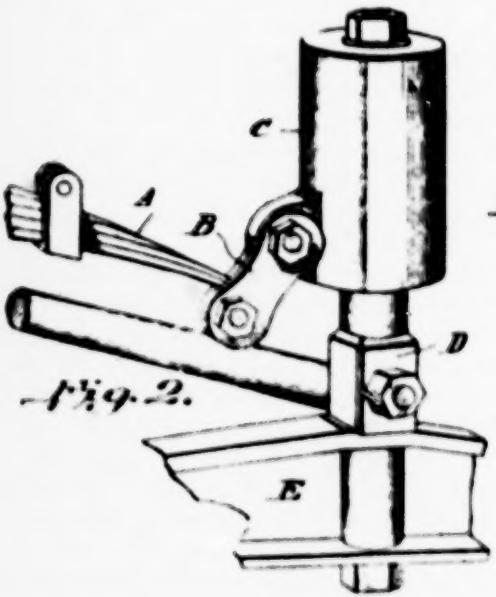


Fig. 2.

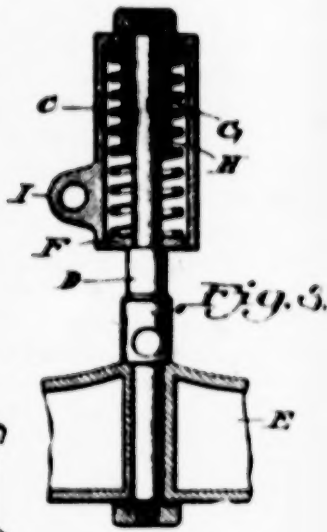


Fig. 3.

Ordinarily at the front axle E, instead of the vertical post or guide D, there is provided in the Ford car a similar post or stanchion D to the upper end of which the links or spring shackles B connect and the same is true of the rear axle except the post D as specified in Claim 4 is fastened to the brake housing which is fixed to the end of the rear axle. Thompson mounts on the vertical pin or guide D a coiled spring G, the upper end being guided by the sleeve H which is fitted to slide up and down on the guide D, the spring G being confined between a washer F at its bottom and the flange of the collar or sleeve H at its top. Also mounted to slide upon the guide or vertical pin D is a

heavy casing or hanger C, the guide D being provided above this casing with a nut engaging the top end of the guide whereby the coil spring will be placed under the desired initial tension. The hanger C is provided with a lug or ear I with which the links or spring shackles B of the car make connection. It will be seen that there is thus interposed at the leaf spring connection with the car a yielding coiled spring instead of merely the ridged or unyielding links B.

It was supposed by the patentee that in this construction under the operation of a load imposed by shock or vibration upon the shackles B, the hanger C would be drawn downward upon the guide D thereby causing the coil spring G to absorb to the limit of its capacity such shocks or vibrations. In other words the coil spring being the weaker or more sensitive spring of the two it would quickly respond to and tend to absorb the slight shocks and vibrations which the leaf spring will not absorb. But the patentee found that when a load was placed upon the shackles B the hanger C was cramped or thrown sideways so that it imposed very considerable friction between the hanger C and the washer F at the lower end, and between the collar or sleeve H and the guide D at the upper end.

Thompson appreciated this difficulty and only three months after the patent issued he applied for another patent on coiled spring shock absorbers in which the friction was done away with by eliminating the friction forming sliding guides of the patent in suit. We shall hereinafter discuss this second Thompson application.

The Claims.

The four claims of the patent are:

1. In Automobile construction, the combination of a non-rotating axle for the ground wheels, of pins or slides attached to and upwardly projecting from said axle, slid-

ing members for said upwardly projecting pins or slides, and a coiled spring interposed between the axle and the sliding member, leaf springs arranged transversely of the car and above the axle and attached at their middle portion to the chassis frame and linked at their outer ends to the sliding members.

2. In Automobile construction, the combination with the axle of the ground wheels, of stems attached thereto and upwardly projecting therefrom, the said stems acting as guides for the vertical movement of enlarged sleeves fitted through an opening in their top to said stems, coiled springs surrounding said stems, said coiled springs being enclosed within said sleeves and adapted to support their downward thrust, shoulders on said stems upon which said coil springs rest, and leaf springs supporting the chassis frame in their mid-length with their outer ends attached to said sleeves, all as substantially shown and described.

3. In Automobile construction, wherein coiled springs are used auxiliary to leaf springs for absorbing shock to the road wheels, the combination of upright stanchions with the axle of the ground wheels, said stanchions being attached to the outer ends of said axle, leaf springs extending above the axle and between the stanchions, and supporting the chassis frame, the said stanchions being adapted to limit the end motion of the leaf springs and thereby prevent side sway of the chassis frame, hangers for the outer end of said leaf springs, said hangers having a vertical movement and being guided therein by said stanchions, and coiled springs interposed between said leaf spring hangers and said axle of the ground wheels.

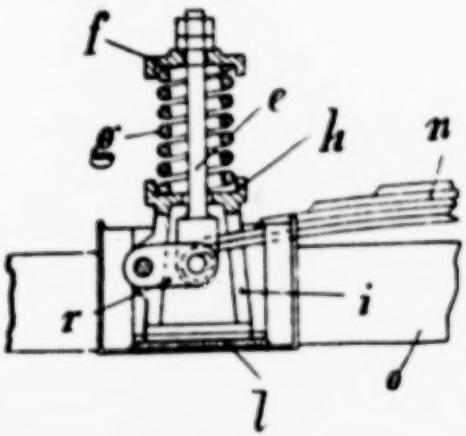
4. In an Automobile, the combination with a leaf spring, a stationary guide on the stationary end of the axle flange adjacent to the rear brake drum and a sliding hanger

..dapted to slide on the said stationary guide, a coiled spring adapted to yieldably support said hanger, the said hanger being adapted to carry the end of the leaf spring.

THE PRIOR ART.

Petitioner's patentees were compelled to narrow their claims down to the specific device of the drawings in view of rejections based on the prior art, that prior art did not include the devices hereinafter referred to but it was sufficient to show that there was no room for anything other than a patent on the specific disclosure. This record shows numerous instances of shock absorbers employing a sensitive coil spring in combination with the more resistant leaf spring usually employed on vehicles for absorbing the wheel shocks.

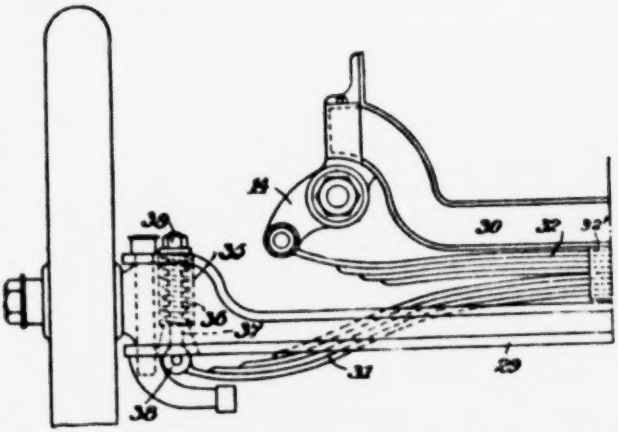
Bussing Patent 3385 of 1907:



The leaf spring is indicated by the reference letter n, being the usual arrangement. The center of the springs being connected with the axle and the ends of the springs

being connected by shackles to brackets which extend from the chassis. With the Ford car, the center of the spring is connected to the body of the car and the ends of the springs being connected by shackles to the axles. If figure 1 of the Bussing patent be turned upside down, as shown, it will illustrate the Ford arrangement, assuming the chassis o to be the axle and the spring n to be connected to the body. The Ford arrangement, in other words, is simply the usual arrangement turned upside down, the springs extending crosswise of the car at each end instead of lengthwise thereof. With the Bussing patent, the ends of the leaf springs **n** are connected by links r to rods e, having washers f thereon, the position of which may be adjusted by nuts appearing on the lower ends of the rods e. Between the washer f and the bracket **h** is a coil spring g. The fore and aft strains which are imposed upon the spring are taken care of by radius links r. It will thus be seen that the weight of the chassis rests upon the coil spring g, thence upon the washer f, and finally the ends of the leaf spring n. In other words, the leaf spring will be connected to the chassis through the intermediation of coil spring shackles in precisely the same way, so far as the broad principle is concerned, as with the Thompson patent in suit. When small rapid shocks are encountered with the construction of the Bussing patent, the leaf spring acts practically as a rigid element and these shocks, instead of being communicated to the body or chassis, are absorbed by the coil springs.

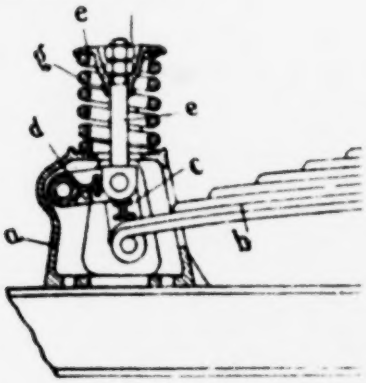
Anger Patent 1,031,612:



This is merely another example of the old principle of connecting the ends of a leaf spring to the axle or chassis of an automobile by means of a quick acting coil spring.

The broad claims of petitioner's patent were rejected on references including Anger, and rejection acquiesced in without appeal and were cancelled and the narrower claims of the patent substituted.

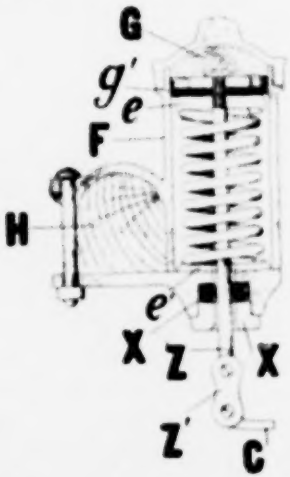
German Patent 227,226 of 1909:



The support or bracket **a** is mounted on the chassis and has pivoted to it the radius links **d** which connect to the spring shackles **c** and the end of the rod e. Between a cap or washer e' at the opposite end of the rod e and the support a is interposed a coil spring g. The leaf spring b connects with the shackle links c.

This patent was not before the Court of Appeals in the Sixth Circuit.

Williams Patent 203,863:



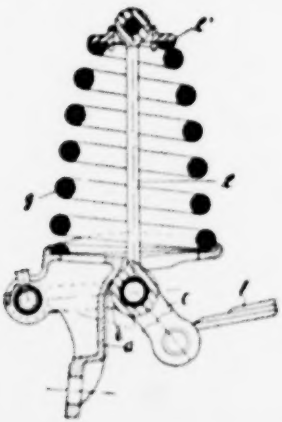
The patent shows a shock absorber fastened to the side bar H of the axle of a horse drawn vehicle. The leaf spring C of the body of the vehicle connects by means of shackle links Z' to the hanger Z the top of which is provided with a discs or washers e and g'. The hanger Z and the discs e and g' slide in the casing F. Between the top disc e and the bottom disc or washer e' is a coil spring.

This patent was before the Court of Appeals of the Sixth Circuit.

RESPONDENT'S SHOCK ABSORBER.

The respondent's shock absorber is made under the patent granted to William Storrie as the result of an award of priority of invention in an interference between the petitioner's patentee Thompson, J. A. Williams of the K-W Ignition Company, one Voight of San Francisco, and Storrie of the respondent's company, Apco Manufacturing Company.

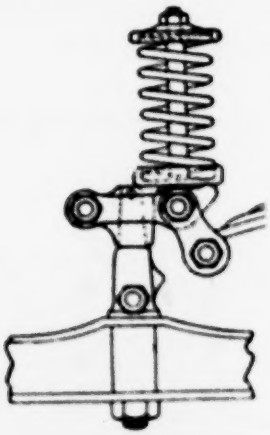
The Storrie-Apco absorber is here illustrated:



The support **a** has pivoted to it the links **d** to which in turn at their opposite end are pivoted to the lower end of the rod **e** the top of which has the washer **e'** resting on a "bee hive" coil spring **g** which is supported at its broad base on the member **a**. The shackle links **c** connect the rod **e** with the leaf spring **f**.

The advantage of this construction is that the coil spring is utilized in such a way that no sliding guides are necessary to keep the coil spring from displacement and consequently there is generated no friction to "dampen" or retard the action of the spring.

This device is known as the "radius link" absorber and with the exception of the shape of the coil spring it is identical with the design of the second Thompson absorber of the interfering application of Thompson. An illustration of the Thompson radius link absorber is here shown:



THE STORRIE-THOMPSON INTERFERENCE.

Three months after the patent in suit issued, Thompson applied for a patent on the radius link shock absorber shown above. The Patent Office cited the patent in suit against this radius link absorber and petitioner's counsel herein, responding to the citation said (respondent's exhibits 7, and 28):

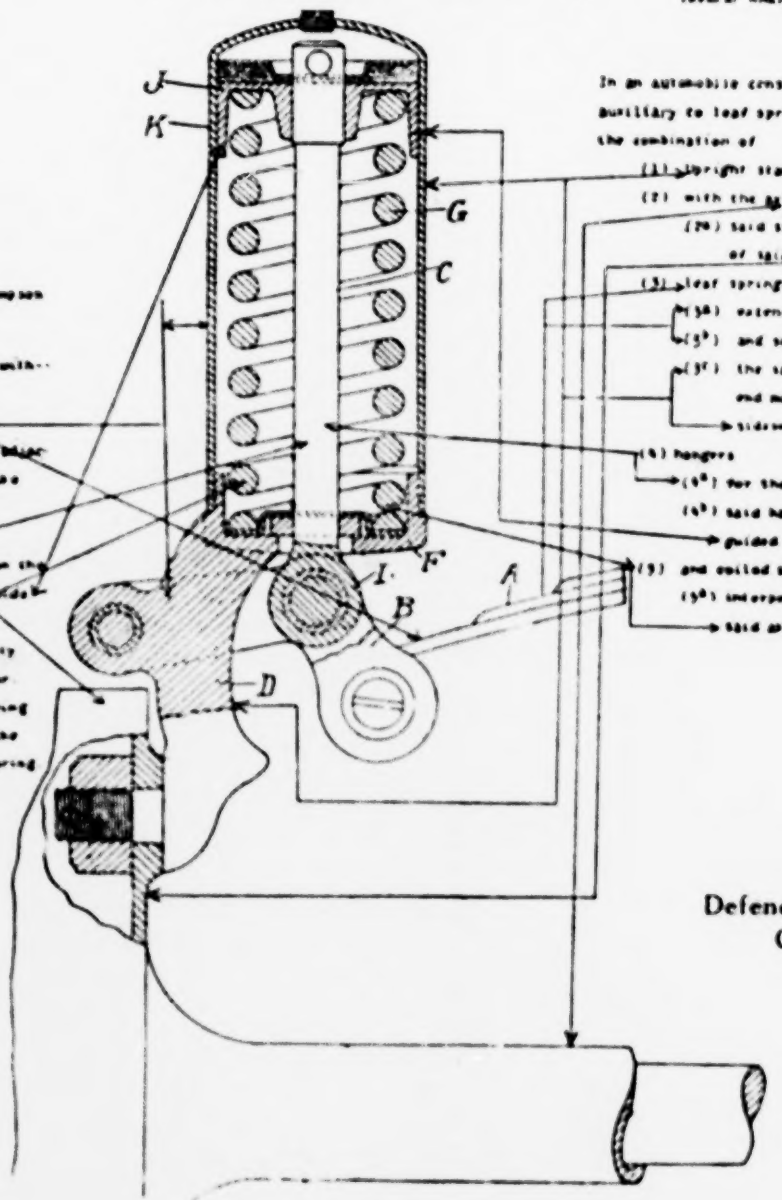
> "The difference between the mechanism and functional result of the present case (radius link absorber) and the former Thompson patent is obvious."

Several claims were then allowed to Thompson in his second application, of which the following claim is typical:

> "In a vehicle spring suspension device, the combination, with an axle, a support secured thereto, and a

Complainant's Infringement Illustration.
Defendants Attachment

K-W-Ignition Company



Patent In Suit

Tabular Analysis of Claim 5 of Thompson Axle Attachment Absorber

In an automobile construction, wherein coiled springs are used auxiliary to leaf springs for absorbing shock to the road wheels, the combination of

(1) uprights or stanchions,

(2) with the axle of the ground wheels,

(2a) said stanchions being attached to the outer ends of said axle,

(3) leaf springs

(3a) extending above the axle and between the stanchions

(3b) and supporting the chassis frame

(3c) the said stanchions being adapted to limit the end motion of the leaf springs and thereby prevent sideway of the chassis frame,

(4) hangers

(4a) for the outer ends of said leaf springs,

(4b) said hangers having a vertical movement and being guided thereon by said stanchions

(5) and coiled springs

(5a) interposed between said leaf spring hangers and said axle of the ground wheels

Patent In Suit

Tabular Analysis of Claim 4 of Thompson Axle attachment Absorber

In an automobile, the combination with--

(1) a leaf spring

(2) a stationary guide--

(2a) on the axle flange bolted to the rear brake drum

(3) and a sliding hanger--

(3a) adapted to slide on the said stationary guide

(4) a coiled spring--

(4a) adapted to yieldably support said hanger

(4b) the said hanger being adapted to carry the end of the leaf spring

Defendant's Exhibit 4 Plaintiff's Chart in K-W Case.

radius link pivoted to said support, of two classes of springs arranged substantially in the plane of said axle, one being a substantially horizontal leaf spring and the other a coil spring substantially in the vertical, the former connected to the radius link and the latter carrying a rod connected to the radius link and supported by said support."

At the time petitioner made this admission in the second Thompson case, it was not aware of Mr. Storrie or his application for patent for the radius link device. The petitioner had abandoned the device of the patent in suit because of its substantial inoperativeness due to the fact that the spring shackles connected to the side of the casing-hanger pulled the casing to one side and cramped it against the vertical pin or guide rendering the coil spring largely non-responsive; due to the resultant friction of the parts.

The claims of the second Thompson application on the radius link absorber formed the counts of the interference and were awarded to Storrie by the Patent Office and the Court of Appeals of the District of Columbia.

THE K-W INFRINGING ABSORBER.

We attach opposite this page an illustration of the shock absorber that was held by the Courts in the Sixth Circuit to infringe the patent in suit. This cut is a copy of the chart used by petitioner in that case.

It will be seen that no reference to the radius link appears on this chart but that the vertical guide and hanger of the claims of the patent are indicated by the heavy fixed casing and the disk or plunger at the top of the guide.

There was introduced on the trial of the case as an Exhibit by the respondent a certified copy of pages 186, 187 and 188 from the transcript of the proceedings on the trial

of the K-W Ignition case before Judge Clarke. From this certified copy we quote as follows:

> "Mr. Thurston (Counsel for the K.-W. Ignition Co.): Now, I desire to offer in evidence certain depositions which were taken in the Storrie matter, which has been stipulated in, subject to objection, taken in the interference proceeding, the depositions to prove the invention by Storrie of the radius link characteristic. * * * That is, if there is anything in the radius link—which is outside the patent. * * *
>
> "The Court: Is there any objection to this?
>
> "Mr. Toulmin: (Counsel for plaintiff, The Temco Co.): Yes.
>
> "The Court: Is it claimed for the patent in suit that it includes this link? (The radius link).
>
> "Mr. Toulmin: **No, sir,** but the patent in suit is represented by the defendant's device and the complainant's device, **with the radius link added to these commercial structures** shown as the defendant's device and to our later form by ourselves. * * * Now, Brother Thurston, as I understand him, was introducing this Storrie testimony for the purpose of establishing the date for possession of the radius links by Storrie prior to the time that we possessed them. That is not an issue here * * *".

That this position taken by the petitioner in the K-W case is consistent with its attitude toward the patent and the K-W infringing device, throughout the trial of the case, is apparent from the following testimony appearing at page 35 of the record in the K-W Ignition case, filed herein as plaintiff's Exhibit 14, in which the cross-examination of petitioner's own expert produced the following:

> XQ. 13: "In defendant's device what do you regard as the hangers, which are guided vertically as specified in the latter part of **claim 3**? A. The part to be coupled to the end of the leaf spring and comprising **the rod**

so coupled, **and the disk on the upper end of the rod, which parts are guided in the fixed casing.**"

And to show that the petitioner regarded claim 3 as being the same in scope as the other claims, and particularly the same as claim 4, we quote petitioner's expert's testimony on cross-examination further:

> XQ. 15: "In defendant's device what do you regard as the sliding hanger which is adapted to slide on the stationary guide, as specified in claim 4? A. The **disk** which slides **in** the fixed guide and which hangs on the upper end of the coil spring and which is intended to be connected by the spring rod to the end of the lead spring."

Turning to pages 94 and 95 of the K-W Ignition Company record, we find Mr. Toulmin, counsel for the petitioner, cross-examining defendant's expert and the court making certain observations as follows:

> XQ. 25: "Then, if the sliding casting is guided by the cap, why is not the upper part of the spring also guided, seeing that the top of the spring end and the casting are in contact and under pressure? A. There would be some guiding there, but it would not be a guiding action which would support indefinite alignment of the parts, due to the fact that they are not mechanical fits, not mechanically arranged for guiding functions.
>
> XQ. 26: "**Aside from anything like hair-splitting, you would say 'yes,' would you not, to the question that the upper part of the cap guides this casting to which the spring or against which the spring is in contact in use? A. Yes, due to the fact that it has a dash-pot** (Note: The packing washer on the casting to trap the air on upward movement, as in a door check) **piston.**
>
> XQ. 27: "The dash-pot function that you have described or referred to is not included in my question. **I want you to confine yourself to the single proposition**

whether or not the casting which travels in the upper part of the casing is guided by the casing and the spring, being in firm contact with the casting is also guided.

The Court: "**That is the last time this question will be allowed, and we want a plain, frank answer.**

A. "The casting is guided in the cylinder and, in so far as the spring is in firm contact with the casting, it is guided.

The Court: "**Clearly so. It does not take an expert to see that.**"

Further, petitioner's expert, Mr. Nathan, as shown at pages 128 and 129 of the K-W Ignition record, supports this contention of the petitioner. He stated (p. 129):

"Of course, in the defendant's device, there is a slide at the upper end also, **as there is in the device of the patent.**"

and (p. 128):

"The Court: **Is that stanchion integral with the cover in the defendant's device?**

"The Witness: **Yes, your Honor, it is screwed on there. It is for all intents and purposes, an integral part.**"

QUESTION OF INFRINGEMENT.

The defenses of the respondent are:

1. Non-infringement on the face of the claims and specifications.

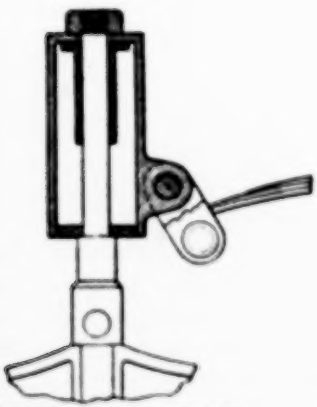
2. Non-infringement of the claims as limited by the estoppel of the file contents, and non invention (established by the decision of the Primary Examiner not appealed from but acquiesced in to obtain the patent and therefore bind

ing) of that for which petitioner now attempts to interpret the claims and non-infringement in view of the prior art.

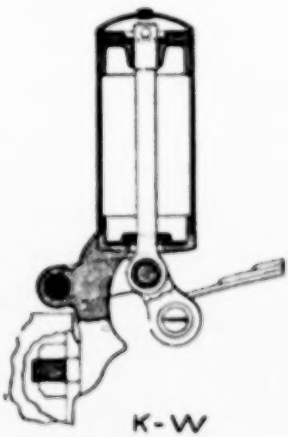
3. Non-infringement of the claims as interpreted in the decision of the Primary Examiner procured by Thompson for the purpose of obtaining a patent on the radius link shock absorber which, however, was awarded respondent's inventor Storrie.

I.

It will be apparent to the court from an inspection of the accompanying illustration that if from either the



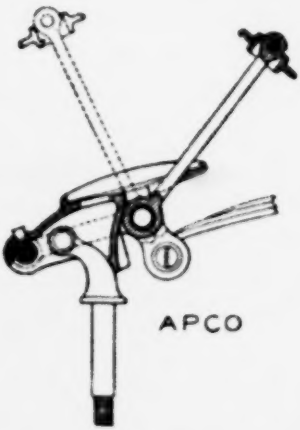
PATENT IN SUIT



K-W

Thompson device of the patent in suit or the K W device held to be an infringement, we remove the coil spring, as shown, and which is a distinct element in the claims of the patent in suit, **the remaining parts still function as guide and guided part just as though the spring had not been removed. That is, the removal of the spring does not affect the relative relationship of the parts nor destroy the guide of the claims.**

Now referring to the illustration of the Apco absorber wherein the coil spring has been removed, **it will be seen that nothing remains to guide the vertical spring link or rod.**



It will thus be seen that in the Apco device the respondent does away with one of the necessary and vital elements of each of the claims of the patent in suit (including claim 3 if we read into that claim mechanism necessary to make it complete), namely the guide for the spring. (See quotations above from K-W record that petitioner and Court regarded these guides as necessary elements in the claims and the infringing K-W structure.)

II.

Petitioner first drew broad claims to the shock absorber but was compelled to narrow them down to the specific device of the drawings. The following claim is one of several that petitioner cancelled before accepting the narrower claims of its patent, in view of the prior art, instead of appealing:

"In an automobile the combination of a series of springs for supporting the frame from the axles, the said series of springs consisting of leaf springs arranged horizontally and coiled springs arranged vertically, said coiled springs being adapted to support the ends of the leaf springs, the said coiled springs being adapted to receive the vertical shocks from the ground wheels and to transmit the same to the ends of the leaf springs lessened to a certain degree by the resiliency of the coiled springs."

This Court will note that petitioner refers to certain broad statements in the specification of the patent in suit. Petitioner cannot broaden its claims of its patent by reference to parts of its specification which was not amended at the time of cancellation of the claims therefor.

In the case of Lehigh v. Mellon, 104 U. S. 112; 26 L. Ed. 639, this Honorable Court said:

"In this case the description of appellant's invention is much broader than his claim. It seems quite clear from the present form of the appellant's specification and from the fact that his application for a patent was twice rejected, that he was compelled by the Patent Office to narrow his claim to its present limits before the Commissioner would grant him a patent. **In doing this he neglected to amend the descriptive part of his specification.** He can not go beyond what he has claimed and insist that his patent covers something not claimed, merely because it is to be found in the descriptive part of the specifications."

This case is particularly in point because the petitioner's brief quotes at great length from the opinion of the Courts in the K-W case, those portions wherein the Court comments upon the general action which the patentee's specifications state takes place in the operation of the shock absorber and the absorption of shocks. The Court will bear in mind that these observations of the Courts in that

case were general observations **predicated upon the specific structure with which they were dealing in finding the patent valid and the claims infringed** and that such descriptive or explanatory statements of the Courts in that case should not be construed, at least under the decision of **Lehigh v. Mellon**, to mean that the presence of such parts in the specification of the patent indicates on the part of the patentee a refutation of his acquiescence in the rejection of the broad claims which were originally drawn or based upon the descriptive part of the specifications.

III.

To find infringement this Honorable Court must ignore the rule that acquiescence in the rejection of a claim when accompanied by the allowance of a narrower claim, estops a patentee from demanding for the claim he got an interpretation which would cover what he was not given.

The patentee Thompson first sought a patent for the broad idea of a coil spring between the end of a leaf spring and the axle (the only place where a shock absorber could connect with the eye of a leaf spring in the Ford car and other automobiles, as fully shown in the prior art as hereinafter discussed). These claims were rejected on the prior art and the claims eventually narrowed down to the claims of the patent in suit, calling for the upstanding fixed pins as vertical guides of the patent. If the broad claims had been allowed it may be that the defendant's shock absorber would infringe. But the claims were not allowed. They were rejected as being too broad, over the prior art cited which showed it was old to employ a coiled spring shock absorber on the end of a leaf spring whether connecting with the axle or the body of the car.

Thompson acquiesced in the rejection by amending instead of appealing and he is thereby absolutely committed

to the claims which he elected to take in his patent. His acquiescence in the rejection of the Patent Office for the purpose of obtaining the patent makes it **res adjudicata**. It cannot be reopened for discussion, for it is foreclosed.

In the case of **Knapp v. Morss**, 150 U. S. 221 (37 L. Ed. 1059), this Court held:

> "A claim in a patent must be interpreted with reference to the rejected claims and to the prior state of the art, and can not be so construed as to cover **either** what was rejected by the Patent Office **or** disclosed by prior devices."

It is only necessary for the Court to see that the original claims were rejected, and that, instead of appealing, the applicant amended to avoid the rejection. It is immaterial whether the rejection was for complete anticipation by a single reference or for lack of invention in view of two references. The essential fact is not denied here, that there was a rejection and that to avoid this rejection the claims were limited by amendment instead of appealing. If, however, we go into the unnecessary consideration of the reference, it will be found that respondent's construction is, in fact, more nearly like that of the prior art as will be apparent from examination of the prior devices hereinbefore illustrated, than like the Thompson patent in suit.

Estoppel of the File Contents of a Patent Cannot Be Neutralized by the Doctrine of Equivalents.

Yates vs. Smith, 271 Fed. 33 (C. C. A. 3rd); **D'Arcy Spring Company vs. Marshall**, 259 Fed. 236 (C. C. A. 6th):

> "We think the conclusion must follow that **the expressly stated limitation cannot be overcome by applying the rule of equivalents** and that the patentee intended and understood his monopoly to be confined to a structure in which the springs had the alternate rela-

tionship which he specified. We are confirmed in this conclusion as to his intent by what occurred in the Patent Office."

The radius link feature was not considered an equivalent of anything in the petitioner's device by the petitioner and petitioner's patentee Thompson when he was seeking a patent on the radius link structure, nor by the courts in the K-W Ignition case. Petitioner and the court in the K-W Ignition case regarded it as an **added** feature to the combination which was held to be an infringement of the patent in suit. In the Forest City case reference is made to the radius link structure as having a guiding function in the later device of the Temco Company, but no question of a radius link combination constituting an infringement of the Thompson patent (the patent in suit) was raised or passed upon in the Forest City case.

The petitioner completely ignores the estoppel of the file contents and undertakes to place the infringement of its patent by the device manufactured by the respondent upon the theory that if it is possible in the search of the combined parts of the respondent's device to find what the petitioner chooses to term an equivalent of some other part in the petitioner's patent, then its patent has been infringed. This not being a generic patent, this cannot be true where the devices are different combinations, though they serve the same general purpose. As we have already stated, the patents must be regarded in their narrow and limited scope and any other combination of parts seeking to perform the same general result is a different device dependent upon its own combination. It probably would be impossible to make any device, under the petitioner's theory, intended to accomplish the same purpose in which you could not discover what could be termed the equivalents in the other device. In other words, if the patent is not generic, each one depends upon its own particular combination without

regard to whether these parts perform particular purposes or not.

Indeed, the petitioner's argument shows that the petitioner is driven to the proposition of claiming the radius link (which it had heretofore disclaimed, as appears from the quotation herein set out from the transcript of the record in the K-W Ignition case) as being within the patent in suit, and by some sort of an imaginary method the stationary stanchion or upright pin of the patent.

That the radius links constitute new and different elements with different functions from any contained in the Thompson patent can hardly be disputed unless the Thompson patent at this late date, and contrary to the position assumed by the petitioner and forming the basis on which the court adjudged its validity and found infringement in the K-W case, is to be given an extremely broad and liberal construction such as is given only to pioneer patents. That this is true is evidenced by the fact that the patentee of the patent in suit himself so regarded it and did not consider that it was covered by his original patent when he applied for a new patent on a new combination employing the radius link. If he thought that it was a mechanical equivalent of what he already had, he did not need a new patent. If it was in his opinion not a mechanical equivalent (and he so stated in his second application, defendant's exhibit 7, page 28 thereof, Thompson-Storrie interference record) then he had a right to apply for a new patent, which he did.

In support of this proposition we respectfully call attention to what this Honorable Court said in the well considered case of **Miller vs. Eagle Manufacturing Company**, 151 U. S. 186, where the second head-note is as follows:

> "No patent can issue for an invention actually covered by a former patent, especially to the same pat-

entee. Although the terms of the claims may differ, in such case the second patent is void."

And (ninth head-note):

"A single element or a function of a patented invention can not be made the subject of a separate and subsequent patent."

The case just cited clearly points out that where the patent is merely for a combination of old elements, the patent must be strictly construed to cover only the combination patented, and that if there are new elements introduced into a new combination employing some or many of the same old elements covered by the original patent, then the new patent is for a different combination and does not infringe the first patent. In support of the fact that the radius link combination structure was considered by every one, up to the time it was necessary for the petitioner to view it otherwise, as a different combination employing a different element, we call the Court's attention again to the fact that all of the authorities in the Patent Office, as well as the Court of Appeals of the District of Columbia, so considered it in bringing the second Thompson application into interference with the Storrie application and in finally awarding a patent to Storrie, notwithstanding the fact that the first Thompson patent, the one in suit, was before the patent authorities and considered by them throughout the interference proceeding. (Defendant's Exhibit 7.)

Not until confronted with the necessities of this case—a suit brought after eight years' delay and after failure to obtain a license from Storrie under the radius link patent; in the face of the position assumed by it before the Patent Office that the radius link structure was not an infringement of the patent; the position assumed before the Courts in the Ohio litigation that the radius links were an addition to the K-W device that otherwise had every element of the

limited claims of the patent in suit,—did the petitioner seek to give to the claims a scope inclusive of the very structures it had disclaimed in order to obtain the patent at all.

As To Claim Three.

No one may read into a claim an element not contained in it.

Deering vs. Winona, 155 U. S. 286.

Again, when a claim is lacking in mechanism or describes a function without indicating the manner of construction or the arrangement or connection of the parts the claim must be restricted, if held valid, to the particular mechanism.

Burr vs. Duryea, 1 Wall. 320;

Merrill vs. Yeomans, 94 U. S. 568.

Nor can the patentee resort to general or vague or ambiguous expressions in the claim to make out a case of infringement. As this Court in the case of **Cimotti vs. American**, 198 U. S. 399, said:

> "In making his claim the inventor is at liberty to choose his own form of expression, and while the courts may construe the same in view of the specifications and the state of the art, it may not add to or subtract from the claim."

And it is equally true that:

> "As the inventor is required to enumerate the elements of his claim, no one is the infringer of a combination claim unless he uses all the elements thereof."

It does not appear that the question of the incompleteness of claim 3 was ever presented to or considered by the Courts in the K-W case in the Sixth Circuit, or in any other case, or that those Courts ever specifically considered claim

3. The patent was held to be valid generally without any special analyses of the several claims. The infringing structure, as we have pointed out, was identical with the device which the petitioner had been manufacturing under its patent and which the K W company had been selling for the petitioner. The District Judge in the K W case stated that he was not without misgiving in sustaining the patent and the Court of Appeals of that Circuit held that the patent was a very narrow one. It was unnecessary for the Court to find infringement of the claim 3 of the patent. Admittedly the K W device was within the terms of claims 1, 2 and 4 of the patent. Assuming that claim 3 was considered by the Courts of the Sixth Circuit, it is not unreasonable to assume that they gave to the claim in question a construction not inconsistent with their findings that the invention was a very narrow one and that the patent must be narrowly construed. It must at least be admitted by the petitioner that claim 3 was not considered broad enough by the Courts in the K W case to include the radius link device because, the Court of Appeals of the Sixth Circuit recognized that the petitioner was not entitled to the radius link device and that the radius link device was conceded to Storrie and was not considered an equivalent of the sliding hanger of the Thompson patent in suit.

We call the attention of this Honorable Court to the fact that the opinions of the Circuit Court of Appeals of the Sixth Circuit do not mention claim 3.

In the Court of Appeals, Fifth Circuit, petitioner cited in support of its contention that claim 3 was complete and not functional, the case of **Winans vs. Denmead**, 53 How. 330. The Winan claim was upheld by this Honorable Court but a reference to the opinion in that case will show that Winan's claim clearly defined apparatus to support the closing functional statement of the claim, whereas in claim 3 of the petitioner's patent there is an attempt to claim, as

the Court of Appeals of the Fifth Circuit said, "the movement of a machine irrespective of the mechanism which causes it."

A reading of claim 3 and a comparison thereof with the specification and drawings of the patent will show that the claim is clearly incomplete and functional. It remains to be said that this is not surprising in view of the fact that patent specifications and claims were drafted by the inventor himself without the assistance of a patent attorney.

The question, however, is academic for even if claim 3 be considered complete it is limited by its terms and the prior art to the specific structure of the remaining claims. Both the Sixth Circuit Court of Appeals and the Fifth Circuit Court of Appeals have found the invention to be a narrow one and the claims not open to such a range of equivalents as would include the radius link structure.

Estoppel by Thompson's Admissions in the Second Application on Radius Link Combination.

In discussing the estoppel by the file contents we have quoted decisions reiterating the legal principle that where the applicant for the purpose of obtaining his patent limits his claims by amendment, he cannot subsequently repudiate such limitations. By the same token an inventor cannot subsequently repudiate a limiting decision of the Patent Office procured by him in seeking application for another device when his first patent is cited against him. Yet this is precisely what plaintiff has attempted here. For the purpose of obtaining a patent on the radius link construction Thompson procured a decision by the Patent Office that the claims of the Storrie patent were for a combination "obviously different in mechanical construction and functional results." Petitioner's counsel seek to overcome the fact of

Thompson's admission before the Patent Office in the second Thompson application that the radius link combination was entirely different in mechanical construction and functional results from the original Thompson patent by stating that the radius link device is mentioned in the specification of the second Thompson application as relating to an improvement over the construction disclosed in the Patent in suit.

As a matter of fact the quotation from the specification of the second Thompson application has just the opposite meaning from that which plaintiff's counsel seeks to get from it. Thompson said that the radius link device related to an improvement "**over**" the construction disclosed in the patent granted to himself. He did not say that it was an improvement **upon** or **in** the device of the patent in suit. **The clear intention of the applicant in this second application was to advise the Patent Office that he was seeking a patent for something over and above the original Thompson device; that it was entirely new and distinct.** If he were seeking a mere improvement upon the original Thompson device he would have said so and he would have formed his claims differently, rather than form his claims into the combinations he submitted. He put no claim in the second application for the mere radius link as applied to his original device **and the emphasis with which he asserted before the Patent Office when it cited the original Thompson patent against him, that the radius link construction was obviously "different in mechanical construction and functional results" shows that he did not regard it merely as an improvement upon the Thompson patent or he would have said so in replying to the Patent Office letter.**

K-W Company and Storrie Licenses.

The Apco Company not only never granted a license under the Storrie Patent to the K-W Company but the tes

timony of Storrie and Wilson of the Apco Company shows that the respondent had no interest in the K-W Company, directly or indirectly, and that the two companies are competitors in the manufacture of accessories for automobiles. Mr. Storrie did grant a license to the K-W Company as his testimony shows, but this license was limited to the use of radius links **with the construction** of the K-W Company absorber using the sliding guides and that K-W did not have any right to use the radius link combination as it is used by the respondent.

We do not believe that the Court will be materially concerned with the various statements, direct and by inference, made in the petitioner's brief to the fact that Mr. Keller, who is now of counsel with the respondent, was of counsel in the K-W case, Penn. Rubber case and the Forest City case. Mr. Keller was retained by Judge Day only on the accounting in the K-W case and in the Forest City case and both Judge Day and he withdrew from those cases before they were completed. Mr. Keller took over the rights in the Storrie patent only as part payment of legal fees, and returned it to Mr. Storrie but Mr. Keller was not aware at that time of the prior radius link Bussing patent hereinbefore described. We think the Court is not interested in any of these matters and that indulging in any controversy about such matters would not be helpful to the Court. It is sufficient to say that the defendant in this case has never been a party to any of those cases.

New York-Atlanta, October 5, 1927.

Respectfully submitted,

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MOSELEY ARTHUR KELLER.
Counsel for Respondent.